UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte R. MICHAEL MCGRADY and R. BARRIE SLAYMAKER Jr.

Appeal No. 2006-1861
Application No. 09/428,035
Technology Center 3600

Decided: May 29, 2007

Before TERRY J. OWENS, STUART S. LEVY and ROBERT E. NAPPI
Administrative Patent Judges.

NAPPI, **Administrative Patent Judge.**

ON REQUEST FOR REHEARING

Appellants have filed a paper under 37 CFR § 41.52 requesting that we reconsider our decision of October 25, 2006, wherein, we affirmed the rejection of claims 4, 6 through 8, 11 through 13, 16 through 18, and 22 through 27 under 35 U.S.C. § 102 (b) and affirmed the rejection of claims 1 through 3, 5, 9, 10, 14, 15, 19 through 20, and 28 under 35 U.S.C. § 103 but reversed the rejection of claim 21 under 35 U.S.C. § 103

Appellants contend that:

i) The legal standard for review was overlooked by the Board;

ii) The burden of proof was misapprehended by the Board;

iii) The Gombrich reference was misapprehended by the Board with respect to claim 4;

iv) The Gombrich reference was misapprehended by the Board with respect to claim 19;

v) The Gombrich reference was misapprehended by the Board with respect to claim 20;

vi) The Gombrich reference was misapprehended by the Board with respect to claim 23;

vii) The Gombrich reference was misapprehended by the Board with respect to claim 26;

viii) There is no legal basis for the ruling of anticipation in the Decision; and

ix) There is no legal basis for the ruling of obviousness in the Decision

We address the Appellants' contentions sequentially.

Appellants' contention i):

On pages 4 and 5 of the Request for Rehearing, the Appellants' assert that "The legal standard of review was overlooked by the Board." The Appellants then recite several Federal Circuit cases. However, Appellants' arguments in support of this contention do not explain why it is believed our

decision of October 25, 2006 does not follow the legal standards.

37 C.F.R. 41.52 (a)(1) states:

> The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.

Appellants' first contention, that "The legal standard of review was overlooked by the Board" does not state with particularity a point misapprehended or overlooked by the Board. Thus, Appellants first contention has not convinced us to change our decision of October 25, 2006.

Appellants' contention ii):

On pages 5 and 6 of the Request for Rehearing, Appellants assert that "The burden of proof was misapprehended by the Board." Appellants argue that the Board's decision is based upon whether the Appellants' arguments proved error in the Examiner's rejection and as such places the burden on the Appellants and not the Examiner. Appellants assert that the initial burden is on the Examiner and not the Appellants.

Our reviewing court has summarized the burden of proof in *In re Kumar* 418 F.3d 1361, 1366, 76 USPQ2d 1048, 1050, (Fed. Cir. 2005), stating :

> During examination, the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *Oetiker*, 977 F.2d at 1445. The *prima facie* case is a procedural tool, and requires that the examiner initially produce evidence sufficient to support a ruling of

> obviousness; thereafter the burden shifts to the applicant to come forward with evidence or argument in rebuttal. *Piasecki*, 745 F.2d at 1475. When rebuttal evidence is provided, the *prima facie* case dissolves, and the decision is made on the entirety of the evidence. *Oetiker*, 977 F.2d at 1445; *In re Spada*, 911 F.2d 705, 708 [15 USPQ2d 1655](Fed. Cir. 1990); *In re Rinehart*, 531 F.2d 1048, 1052 [189 USPQ 143] (CCPA 1976).

As stated on page 2 of the October 25, 2006 decision, the Examiner's rejections are set forth in the Answer. These rejections identify the statutory basis for the Examiner's rejections, specific citations to the prior art which the Examiner relies upon and the Examiner's rationale in support of the rejections. Thus, the Examiner has borne the burden of providing evidence by articulating clear reasoning as to why the Examiner consided the claims to be unpatentable. Clearly this was recognized by Appellants, as on pages 10 through 31 of Appellants' Brief, dated November 4, 2003, Appellants provided specific arguments directed to rebutting the Examiner's rejections. Thus, the record clearly reflects that the Examiner carried the burden of presenting evidence and the Appellants' Brief dated November 4, 2003 presented arguments in rebuttal. As stated in numerous instances in our decision, we did not consider Appellants' arguments to be persuasive. Thus, Appellants' second contention that the burden of proof was misapprehended by the Board, has not convinced us to change our decision of October 25, 2006.

Appellants' contention iii):

On pages 7 through 11 of the Request for Rehearing, Appellants argue that the Gombrich reference was misapprehended by the Board with respect to claim 4 (and claim 1). Specifically Appellants argue that Gombrich does not teach the features attributed to Gombrich on page 5, lines 9-15 of the October 25, 2006 decision. Appellants assert that Gombrich does not teach that the report "includes machine readable indicia corresponding to at least one of the patients and machine readable indicia corresponding to at least one item prescribed for the patient." (Request for Rehearing p. 7.) Appellants assert that one skilled in the art would conclude that Gombrich teaches attaching a label to a medical item which includes a bar code identifying the item and human readable indicia listing other information such as patient's name and other pertinent data. (Request for Rehearing p. 9.) Further, on page 10 of the Request for Rehearing, the Appellants argue that our prior decision has not shown that including a patient' name in the form of a barcode is mandatory in Gombrich. Additionally, Appellants argue that one skilled in the art would find it confusing or illegal to have more than one barcode on a drug package.

The standard for review of factual findings by the PTO is substantial evidence. *In re Gartside* 203 F.3d 1305, 1312, 53 USPQ2d 1769, 1773 (Fed Cir.) Our reviewing court has said:

> Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. In reviewing the record, we must take into account evidence that both justifies and detracts from the factual determinations. We note that the possibility of drawing two

> inconsistent conclusions from the evidence does not prevent the Board's findings from being supported by substantial evidence. Indeed, if a reasonable mind might accept the evidence as adequate to support the factual conclusions drawn by the Board, then we must uphold the Board's determination.

In re Kahn 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) (citing *In re Gartside*, *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)).

In our October 25, 2006 decision we state, on page 5:

> Note: Gombrich teaches that for unique drugs a label with patient barcode, drug barcode and data relating to the administration of the drug will be printed and placed on the drug package. See column 13 line 65 through column 14, line 21. Thus, we find ample evidence to support the examiner's finding that Gombrich teaches the claimed report.

In the cited sections of Gombrich there is no statement that the drug label contains part of the information in a barcode format and part in human readable format. While we recognize that Gombrich, in column 13, line 1-2 teaches that on a different barcode label (patient barcode label) the same information is printed in both barcode and human readable format, we do not find that this teaching leads to a conclusion that part of the information is in a barcode format and a different part of the information in human readable format on the unique drug label. Thus, Appellants' arguments have not shown that our October 25, 2006 decision in which we found that the drug label of Gombrich teaches both drug identifier and patient identifier in barcode format is not supported by substantial evidence. Further, Appellants' statement that more than one barcode would be confusing and of questionable legality are unsupported by evidence in the record.

Appellants further state, on page 10 of the Request for Rehearing, that the Board made an erroneous determination that a drug package label constitutes a report. However, Appellants' statements do not provide a rationale why the determination is in error. Our October 25, decision clearly states, on page 5:

> [A]ppellants' specification on pages 14, 90, 91 and 124 discuss many things that can be in a report, but appellants' specification does not identify any characteristics that make a collection of data a report. From the discussions of reports on pages 14, 90, 91 and 124, we consider the term report to be used to describe a document containing information. We note that claim 4 further recites that the report "includes machine readable indicia corresponding to at least one of the patients and machine readable indicia corresponding to at least one item prescribed for the patient." We consider that the labels of Gombrich teach this limitation.

For the aforementioned reasons Appellants' third contention that Gombrich reference was misapprehended by the Board with respect to claim 4 (and claim 1), has not convinced us to change our decision of October 25, 2006.

Appellants' contention iv):

On pages 12 through 14 of the Request for Rehearing, Appellants argue that the Gombrich reference was misapprehended by the Board with respect to claim 19. Specifically Appellants argue that Gombrich does not teach the feature of dispensing the at least one medical item from a medical item dispenser responsive to reading machine readable indicia on a report as discussed on page 14 of the October 25, 2006 decision. Appellants argue our

decision finds that the IV bag dispenses itself, that the dispensing the drug is not responsive to the scanning of the label but to the nurse receiving a green light. (Request for Rehearing, p. 13.)

Appellants' arguments have not convinced us of error in our decision of October 25, 2006. As stated on page 14 of our decision:

> [W]hen unique drugs are made up, such as a custom IV, a label with machine readable code is also prepared. See column 14, lines 7 through 21. Although not disclosed in Gombrich, it is known to those skilled in the art that IV's are contained in an IV bag which dispenses the drug. Further, Gombrich teaches that prior to the nurse administering drugs, the nurse scans the label on the medication and if no discrepancies are noted, the system will prompt the nurse to administer the drug to the patient. See column 15, lines 9 through 20 and lines 58 through 62. This prompt is responsive to the nurse scanning the label on the medicine. Thus, we consider that one skilled in the art would recognize that Gombrich teaches that when a custom IV is made, it has a label with machine readable code, and when the nurse is preparing to administer the IV (medical item) from the IV bag (medical item container) the nurse scans the label and in response to the scanning is prompted to administer the IV (medical item) from the IV bag (medical item container).

Thus, we did not find that the IV bag dispenses itself but that the IV bag dispenses the Intravenous (IV) drug contained therein. Claim 19 recites "dispensing the at least one medical item from a medical item dispenser responsive to reading machine readable indicia on a report." Claim 19 does not include a limitation which precludes there being interim steps between the reading of the indicia and dispensing the medical item. Further, while the step prior to administering the drug is the nurse receiving the green light, the initial step is the nurse scanning the drug label. For the aforementioned

reasons Appellants' forth contention that Gombrich reference was misapprehended by the Board with respect to claim 19, has not convinced us to change our decision of October 25, 2006.

Appellants' contention v):

On pages 14 through 15 of the Request for Rehearing, Appellants argue that the Gombrich reference was misapprehended by the Board with respect to claim 20. Specifically, Appellants argue that Gombrich does not teach the feature of storing in a data store, data representative that at least one medical item has been taken for use by the one patient, responsive to the at least one medical item being dispensed from a medical item dispenser. Appellants argue that Gombrich teaches recording the drug administrative data before administering the drug and not after the drug was dispensed as claimed. (Request for Rehearing p. 15.)

Appellants' arguments have not convinced us of error in our decision of October 25, 2006. Claim 20 recites "storing in the data store, data representative of that the at least one medical item has been taken for use by the one patient, responsive to the at least one medical item being dispensed from a medical item dispenser." Thus, claim 20 is not limited to storing data after the drug is dispensed, but is broad enough to encompass the storing of data while the drug is being dispensed from the medical dispenser. As discussed on page 14 of our decision dated October 25, 2006, Gombrich teaches that administration of the drug is recorded if there is a green light

(that prompts the nurse to administer the medical item). Thus, there is ample evidence to support our October 25, 2006 decision, and Appellants' fifth contention, has not convinced us to change our decision of October 25, 2006.

Appellants' contention vi):

On pages 15 through 18 of the Request for Rehearing, Appellants argue that the Gombrich reference was misapprehended by the Board with respect to claim 23. Appellants argue that Gombrich does not teach the feature of data indicative that the medical item has been given to the patient is not stored at the step of reading the ID as claimed. Rather Appellants assert that Gombrich teaches that it is stored later, at the time the green light is lit. (Request for Rehearing p. 18.)

Appellants' arguments have not convinced us of error in our decision of October 25, 2006 for the reasons which follow. As identified on page 7 of our decision, Appellants' statements on page 17 of the November 4, 2003 Brief, amount to nothing more than pointing out the differences in the claims and do not constitute a separate argument under 37 C.F.R. 1.192(c). Further, Appellants' arguments on pages 15 through 18, raise issues with respect to claim 23 which were not raised in the Brief and as such not presented before the Examiner. Finally, Appellants' arguments are not commensurate with the scope of claim 23. Claim 23 does not include a limitation which precludes there being interim steps between the reading of the indicia and storing the

data in the portable terminal. For the aforementioned reasons Appellants' sixth contention that Gombrich reference was misapprehended by the Board with respect to claim 23, has not convinced us to change our decision of October 25, 2006.

Appellants' contention vii):

On pages 18 through 19 of the Request for Rehearing, Appellants argue that the Gombrich reference was misapprehended by the Board with respect to claim 26. Specifically Appellants argue that Gombrich does not teach the feature of a fixed bedside terminal. (Request for Rehearing p. 19.)

Appellants' arguments have not convinced us of error in our decision of October 25, 2006. As identified on pages 9 and 10 of our decision:

> [W]e find that Gombrich teaches portable terminals. These portable terminals communicate with a base unit. See item 55 figure 1. Gombrich teaches that the portable terminals are "located in every patient room along with a base unit."

Gombrich teaches that the base units communicate with the computer system using a modem (phone line, twisted pair or RF over power lines). See generally column 9, which are located in the patient's room. Note, we consider these modems to be fixed as they are wired to the hospital's infrastructure. Further, Gombrich teaches that "nonportable bar code reading devices may be used in some areas of the hospital where portability is not necessary or desirable" (Column 8, ll. 63-66.) Additionally, Gombrich teaches that the portable terminal may be connected via a wired

communications port to a vital signs measurement equipment, clearly when so connected they are fixedly attached to the patient's bedside area. For the aforementioned reasons Appellants' seventh contention that Gombrich reference was misapprehended by the Board with respect to claim 26, has not convinced us to change our decision of October 25, 2006.

Appellants' contention viii):

On page 19 of the Request for Rehearing, Appellants argue that for the reasons discussed above Gombrich does not anticipate claims 4, 23, and 26, therefore is no legal basis for supporting the Examiner's anticipation rejection based on Gombrich.

We disagree for the reasons discussed *supra* and as discussed in our decision of October 25, 2006, we find ample evidence to support the Examiner's rejection of claims 4, 23, and 26 under 35 U.S.C. §102. Accordingly, Appellants' eighth contention has not convinced us to change our decision of October 25, 2006.

Appellants' contention ix):

On page 20 of the Request for Rehearing, Appellants argue that for the reasons discussed above Gombrich does not teach or suggest the limitations of claims 1, 19, and 20, therefore is no legal basis for supporting the Examiner's obviousness rejections based on Gombrich.

We disagree for the reasons discussed *supra* and as discussed in our decision of October 25, 2006, we find ample evidence to support the Examiner's rejection of claims 1, 19, and 20 under 35 U.S.C. §102. Accordingly, Appellants have not convinced us to change our decision of October 25, 2006.

Accordingly, while we have granted Appellants' Request for Rehearing to the extent that we have reconsidered our decision, that request is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

REHEARING DENIED

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